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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,731

01/31/2006

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64348(41925)

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7590

08/11/2009

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,731	<b>Applicant(s)</b> HUBSCHWERLEN ET AL.	
	<b>Examiner</b> REBECCA L. ANDERSON	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 6,7 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 1-5 and 8-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-15 and 17 are currently pending in the instant application. Claims 6, 7, and 17 are withdrawn from consideration as being for non-elected subject matter. Claims 1-5 and 8-15 are objected. Claims 1-3, 11-13 and 15 are rejected.

#### ***Response to Amendment and Arguments***

Applicant's amendment and arguments filed 27 May 2009 have been fully considered.

Applicants' amendment has overcome the 35 USC 112 1<sup>st</sup> paragraph rejection as Applicants have deleted all references to "solvates" and "hydrates" from the pending claims.

In regards to the restriction requirement and election of species, Applicant's state that the Examiner has not provided any basis for determining that the elected species is not allowable. This argument is not persuasive as the elected species was considered not allowable due to the 35 USC 112 1<sup>st</sup> paragraph rejection present in the office action mailed 27 January 2009. Therefore, according to MPEP 803.02, the elected species was rejected and claims to the non-elected species held withdrawn from further consideration. It is noted that the Office action mailed 27 January 2009 stated that the elected embodiment was the compound of example 7 (page 3 of the action) and that in the 35 USC 112 1<sup>st</sup> paragraph rejection the solvates and hydrates of the elected embodiment were not enabled (page 4 of the action).

As Applicants' have overcome the 35 USC 112 1<sup>st</sup> paragraph rejection, the elected species now appears allowable. According to MPEP 803.02, the examiner has

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also expanded the search to the species: 4-methyl-2-naphthalene-1-yloxymethyl-morpholine . The elected embodiment now consists of the compound of example 7 and the species, 4-methyl-2-naphthalene-1-yloxymethyl-morpholine, which was not found allowable. Since the elected embodiment was not found allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration.

It has been determined that the entire scope claimed is not patentable.

As the claims are rejected under 35 USC 102(b), the objection to the claims is maintained as the claims still include subject matter drawn to other than the elected embodiment.

### ***Claim Objections***

Claims 1-5 and 8-15 are objected to as containing non-elected subject matter. Claims 1-5 and 8-15 presented drawn solely to the elected embodiment would overcome this objection.

### ***Claim Rejections - 35 USC § 102***

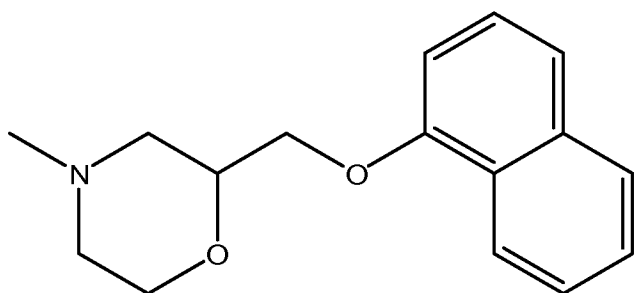
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenwood et al.

Greenwood et al. discloses a number of 2-(naphthoxymethyl)-2,3,5,6-tetrahydro-1,4-oxazines which possess potent antidepressant properties (page 573), such as, for example, the compound 15 wherein Ar is 1-Naphthyl and R is CH<sub>3</sub>, page 574, i.e.



4-methyl-2-naphthalene-1-yloxymethyl-morpholine which corresponds to Applicants' claimed invention wherein R<sub>1</sub> is a hydrogen atom; X<sub>1</sub>, X<sub>2</sub>, X<sub>3</sub>, X<sub>4</sub> and X<sub>5</sub> are each CH; A is an oxygen atom; n is 1; Cy is a heterocycloalkylene, specifically morpholinyl,; m is 0; and R<sub>3</sub> is an alkyl radical, specifically methyl.

### Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

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Rebecca Anderson  
Primary Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

10 August 2009